PATENT
Customer No. 22,852
Attorney Docket No. 04853.0055-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hisashi SEMBA, et al.

Application No.: 09/758,317

Filed: January 12, 2001

For: A METHOD FOR SYNTHESIZING AN OPTICALLY ACTIVE CYANOHYDRIN

Group Art Unit: 1651

Examiner: Irene Marx

#8
B.G.J
4/24/02

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement mailed March 27, 2002, the Office required restriction under 35 U.S.C. § 121 between Group I (claims 11-20), drawn to an immobilized enzyme and a method of making it, and Group II (claims 21-28), drawn to a process of making an optically active cyanohydrin using an immobilized enzyme. Applicants provisionally elect, with traverse, to prosecute Group I, claims 11-20.

Section 803 of the M.P.E.P. states that "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added.) Applicants respectfully submit that this policy should apply to this application in order to avoid unnecessary delay and duplicative examination.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

This search can be made without undue burden because, contrary to the Office's assertion, a literature search for these groups would be coextensive. To illustrate this point, Applicants note that claims 21-28 depend directly or indirectly from claim 11. Therefore, a search for a method of producing an optically active cyanohydrin using the immobilized enzyme of claim 11 (Group II) would involve a search for the immobilized enzyme of claim 11 (Group I). In addition, the subject matter of all of the claims falls within the same class (435). Thus, Applicants respectfully request the Office to rejoin claims 21-28 to claims 11-20.

Finally, according to 37 C.F.R. § 1.141(b) and M.P.E.P. § 821.04, once the Office determines that claims drawn to a product and a process of making it are allowable, claims directed to processes of using the same product may be rejoined. Thus, if the Office maintains this restriction requirement, Applicants respectfully request that the Office rejoin the process of use claims 21-28 once the Office determines that the product and process of making claims 11-20 are patentable.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 22, 2002

By: _____
Elizabeth A. Doherty
Reg. No. 50,894

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com